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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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GROUP 3600

In Re Application of:

Kevan Hatchman, Elvin Lukenbach,

Laura McCulloch and Benjamin Wiegand. Confirmation No.: Not yet assigned

Serial No.: 10/018,238

Group Art Unit: Not yet assigned

Filing Date: December 07, 2001

Examiner: Not yet assigned

For: PERSONAL CARE FORMULATIONS

DATE OF DEPOSIT: January 7, 2003

I HEREBY CERTIFY THAT THIS PAPER IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL, POSTAGE PREPAID, ON THE DATE INDICATED ABOVE AND IS ADDRESSED TO THE COMMISSIONER OF PATENTS AND TRADEMARKS, WASHINGTON, DC 20231.

Wendy A. Choi
TYPED NAME: Wendy A. Choi
REGISTRATION NO.: 66,697

Assistant Commissioner for Patents
Washington DC 20231

TRANSMITTAL LETTER

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OFFICE OF PETITIONS

In response to the "Communication from the Examiner regarding the Petition for Retroactive License under 37 CFR 5.25" dated October 31, 2002, which sets forth a sixty day period for reply ending on December 30, 2002, (said period being eligible for extensions under 37 CFR § 1.136(a)), enclosed herewith is:

1. A Statement of Facts Regarding Failure to Seek U.S. Foreign Filing License Under 35 U.S.C. §184 (Supplemental)

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PATENT

2. EXTENSION OF TERM

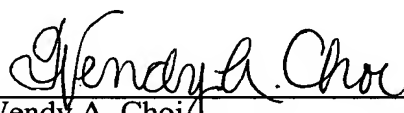
The proceedings herein are for a patent application and the provisions of 37 CFR § 1.136 apply.

- ☒ Petition is hereby made under 37 CFR § 1.136(a) (fees: 37 CFR § 1.17(a)(1)-(4) to extend the time for response to the Communication Office Action of October 31, 2002 to and through January 31, 2003 comprising an extension of the shortened statutory period of one month.

	RATE	FEE	RATE	FEE
<input checked="" type="checkbox"/> ONE MONTH EXTENSION OF TIME	\$55	\$	\$110	\$110.00
<input type="checkbox"/> TWO MONTH EXTENSION OF TIME	\$205	\$	\$410	\$
<input type="checkbox"/> THREE MONTH EXTENSION OF TIME	\$465	\$	\$930	\$
<input type="checkbox"/> FOUR MONTH EXTENSION OF TIME	\$725	\$	\$1450	\$
<input type="checkbox"/> FIVE MONTH EXTENSION OF TIME	\$985	\$	\$1970	\$
<input type="checkbox"/> LESS ANY EXTENSION FEE ALREADY PAID	minus	(\$)	minus	(\$)
TOTAL FEE DUE		\$0		\$110.00

- ☒ A check in the amount of \$110.00 is attached for the extension of time.
- ☒ If any additional extension and/or fee is required, the Commissioner is authorized to charge Deposit Account No. 23-3050 for said additional fee.

Date: January 7, 2003


Wendy A. Choi
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of : Kevin Hatchman, Elvin Lukenbach, Laura McCulloch and Benjamin Wiegand.

Serial No. : 10/018,238

Group No. : Not yet assigned

Filed : 12/07/01

Examiner : Not yet assigned

For : PERSONAL CARE FORMULATIONS

BOX DAC

Office of Petitions

Assistant Commissioner for Patents

Washington, D.C. 20231

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Dear Sir:

**STATEMENT OF FACTS REGARDING FAILURE TO SEEK U.S. FOREIGN
FILING LICENSE UNDER 35 U.S.C § 184
(SUPPLEMENTAL)**

Applicants respectfully request a retroactively granted license under 35 U.S.C. § 1811 to the subject matter of GB 9913408.2, WO 00/76460 and related national stage applications, which were filed outside of the U.S. without a prior license from the Commissioner of Patents and Trademarks through error and without deceptive intent.

Summary of Facts

The subject matter of GB 9913408.2, WO 00/76460 and related national stage applications is directed to personal care formulations, such as shampoo and body wash. More specifically, the subject matter relates to clear, gel-like personal care formulations that contain surfactant, oil and water. The oil may be a mineral oil, fatty ester, glyceride, terpene or silicone oil and the surfactant has an HLB of 2-10.

The technology that is the subject-matter of the applications was jointly developed by Albright & Wilson Surfactants, a subsidiary of Rhodia Consumer Specialities, Ltd. (A&W) and Johnson & Johnson Consumer Companies, Inc. (J&J). A&W is located in the U.K. and develops and manufactures gels. J&J is located in the U.S. and develops, manufactures and sells hair and skin care products. The two parties were working together initially under a secrecy agreement and eventually under a joint development agreement to develop suitable A&W gels for J&J's hair and skin care products.

During a teleconference between personnel of both parties on June 6, 1999, J&J was informed by A&W that A&W intended to file a provisional British patent application directed to an invention made solely by personnel of A&W. Without review by any personnel at J&J, this application (GB 9913408.2) was filed on June 10, 1999 by me, Mr. Roger Savidge, a patent attorney for Rhodia. As a provisional

British patent application, it did not name any inventors (only A&W as the applicant). A copy of the application, as filed, was faxed to J&J on June 10, 1999 (*Exhibit 1 -- previously submitted*). After reviewing the patent application, J&J determined that J&J personnel (who made the invention in the U.S.) were at least joint inventors on the provisional British patent application. Through ignorance of the requirement, neither party realized that, because the invention disclosed in the British application was at least partially made in the U.S., that it was necessary to seek a foreign filing license in the U.S. prior to filing the British application.

On the eve of the Paris Convention deadline of June 9, 2000, I contacted Ms. Michele Mangini, a patent attorney with J&J, to discuss filing a PCT application based upon the provisional British application by June 9, 2000. On June 8, 2000, Ms. Mangini signed, as Assistant Secretary of J&J, and returned via facsimile a document appointing me as the representative for the PCT application (*Exhibit 2 -- previously submitted*).

The PCT application was filed on June 9, 2000 (WO 00/76460)(*Exhibit 3 -- previously submitted*). There were four inventors listed on the PCT application:

- (1) Kevan HATCHMAN (A&W)
- (2) Elvin LUKENBACH (J&J)
- (3) Laura McCULLOCH (J&J)
- (4) Benjamin WIEGAND (J&J)

Inventors (2)-(4) made at least a part of their contribution to the claimed invention in the U.S. and while residing in the U.S. I handled the prosecution of the PCT application with input from J&J. The PCT application is essentially identical to the provisional British application. In haste to secure a filing date and again through continuing ignorance of the requirement, neither party realized that, because the invention disclosed in the British and PCT applications was at least partially made in the U.S., that it was necessary to seek a foreign filing license in the U.S. prior to filing the PCT application and seek a retroactive license with respect to the provisional British application.

At the 30-month deadline for entering Chapter II of the PCT, I engaged a U.S. patent attorney, Mr. Marshall Chick of FRISHAUF, HOLTZ, GOODMAN, LANGER & CHICK, to file a U.S. national application (SN 10/018,238 on December 7, 2001) based on the PCT application. National applications were also filed at the EPO and in Australia, based on instructions from me (*Exhibit 4* and *Exhibit 5*, respectively -- *previously submitted*). Instructions were sent to a Canadian agent to file a Canadian national application. However, due to conflicting instructions by J&J, the Canadian agent did not file (and has not yet filed) the application in Canada (*Exhibit 6 -- previously submitted*). Applicants intend to file the application in Canada, provided that and only after the retroactive license requested herein is granted.

On or about January 15, 2002, Mr. Chick contacted J&J to collect details to prepare a post-filed declaration, power of attorney and assignment (*Exhibit 7 -- previously submitted*). In reviewing the application papers from Mr. Savidge, Mr. Chick discovered that there was no record of the granting of a U.S. foreign filing license. He inquired whether J&J had sought a U.S. foreign filing license and could not confirm that either party had sought such a license.

On February 6, 2002, Mr. Chick forwarded the U.S. application (*Exhibit 8 -- previously submitted*) to Wendy Choi of WOODCOCK WASHBURN LLP, a law firm now representing J&J, to handle the prosecution of the application, including seeking a retroactive foreign filing license.

I have prepared this statement of facts to support the petition for a retroactively granted license under 37 C.F.R. § 5.25.

Conclusion

Applicants respectfully request a retroactively granted license under 35 U.S.C. § 184 and 37 C.F.R. § 5.25 to the subject matter of GB 9913408.2 and WO 00/76460 and related national stage applications, which were filed outside of the U.S. without a license from the Commissioner of Patents and Trademarks. Applicants submit that:

- (1) the applications that were filed without the required licenses under 35 U.S.C. § 184 were filed through error and without deceptive intent;
- (2) the subject matter of the applications was not under a secrecy order under 35 U.S.C. § 181 at the time that the applications was filed abroad, and the subject matter is not currently under a secrecy order; and
- (3) they are promptly seeking a retroactive license under 35 U.S.C. § 184 and 37 C.F.R. § 5.25 after discovery of their error in not seeking the required license.

The required fee in accordance with 37 C.F.R. § 1.17(h) was previously submitted.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under 18 U.S.C. § 1001.

Respectfully submitted,


Roger G. M. Savidge

Date: December __, 2002

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